

Lawyers' Office

DAVID, LIENERT & RAMER

Draft of

9th June 1987

To the

Commercial Court of the Canton of Zürich

P.O. Box

8023 Zürich

In the matter of

Fabriques des Tabac Réunies S.A., Quai Jeanrenaud 3,
2003 Neuchâtel,

Plaintiff,

represented by Dr. Lucas David,

Bahnhofstr. 58, 8001 Zürich,

versus

Brown & Williamson, Tobacco Corporation, 1500 Brown &
Williamson Tower, Louisville, Kentucky, USA,

Defendant,

represented by Dr. Ing. Hans A. Troesch and Dipl. Ing.

Jacques J. Troesch, Patent Agents, Walchestr. 19,

8006 Zürich,

concerning revocation of a patent

I hereby enter an

action

in the name of and with the authority of the Plaintiff,
with the petition:

That the following Swiss/Liechtenstein patents be
revoked by the court:

1. No. 645,252 relating to a cigarette filter, applied for
on 3rd April 1980 and granted on 28th September 1984,
2. No. 657,755 relating to a smoke filter, applied for on
2nd February 1983 and granted on 30th September 1986,
and
3. No. 658,775 relating to a cigarette filter and a process
for its manufacture, applied for on 27th January 1983
and granted on 15th December 1986,

with costs and damages against the Defendant

Value in litigation: approx. SF 20 million

Annex 1: Plaintiff's power of attorney, undated

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Grounds:

1. Preliminary remarks

1. The burden of proof lying with the Plaintiff, legally sufficient proof is submitted in respect of the entire statement of facts, with the proviso that individual items of evidence may be reserved until a later date (§ 141, Code of Civil Procedure).
2. The undersigned lawyer is duly authorised to act (cf. Annex 1).
3. The jurisdiction of the court to which application is made is justified in accordance with Article 75, Section 1, Clause b of the Patent Act. The cantonal jurisdiction under the provisions of § 10 ZPO is not being invoked. The Defendant has no residence in Switzerland. The Defendant's patent agent, as entered in the Register, has his place of business in Zürich, so that the Zürich judge has jurisdiction. The Commercial Court has jurisdiction for actions under patent law, without recourse to the justice of the peace (§ 61, Section 1, Clause 1 of the Judiciary Act, § 103, Clause 1 of the Code of Civil Procedure).

Evidence submitted:

Annex 2: Extract from Swiss Register of Patents No.

645,252, dated 9th May 1986 (Johnson)

Annex 3: Extract from Swiss Register of Patents No.

657,755 dated 26th May 1987 (Luke)

Annex 4: Extract from Swiss Register of Patents No.

658,775 dated 26th May 1987 (Lamb)

4. The revenue from the tobacco tax in 1985 (including import duty on tobacco but excluding sales tax) was SF 844 million, and in 1986 it was SF 797 million. This corresponds to tobacco sales of more than SF 2,000 million or approx. 17,000 million units. The present market share of the Barclay cigarette produced by the Defendant is probably just under 5% (1983 3.4%, 1984 4.7%, 1985 4.4%, 1986 4.6%), which is to say more than SF 100 million or 800 million units per year. Given that the first patent in dispute has a residual period of validity of 13 years, this corresponds to a sale of approx. SF 1,500 million.

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Since, as a rule of thumb, the value of a patent corresponds to approximately 5% of the net sales value of the patented article, the Plaintiff estimates the value in litigation of the disputed patent at approx. SF 20 million.

2. On the facts of the case in general

5. The parties are competitors in the cigarette industry.

The Defendant, a member of the British-American Tobacco Group (BAT), manufactures the cigarette Barclay, which has been on sale in Switzerland since about October 1983. The Barclay cigarette is a filter cigarette which has subsidiary air passages through which the smoker is supposed to draw in fresh air. This fresh air is intended to dilute, within the oral cavity, the main stream of smoke which is drawn in, and thus to reduce the relative nicotine and tar levels. The methods of measurement by which these levels were ascertained have already given rise to legal action in Switzerland and elsewhere, but these proceedings are of no further relevance in the present context.

The Defendant applied for a patent for the Barclay cigarette under No. 2656/80 on 3rd April 1980, an American priority of 11th April 1979 being claimed for this patent. The application resulted, on 28th September 1984, in Swiss/Liechtenstein Patent No. 645,252 (hereinafter briefly referred to as the Johnson Patent, after the inventor, or the first patent in dispute). In essence, this claims a filter for a cigarette, characterised by a porous filter rod (2) of cylindrical shape, a non-porous wrapping sheet (12), which extends along the rod (2) and wraps the latter, but whose ends are left open to allow free flow, the wrapping sheet (12) and the rod (2) possessing a plurality of longitudinally extending, peripherally distributed, mutually spaced grooves (14), which grooves (14) extend over a certain length from at least one end, and further characterised by tip material (16), which extends in the longitudinal direction and envelops the wrapping sheet (12), this tip material (16) being permeable to air, which makes it possible for the ventilation air to flow through the tip material into the grooves, this air being the only

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fluid which flows through these grooves when a smoker draws normally on a cigarette fitted with this filter.

The intention of this is to enable the cigarette filter to combine the pressure drop of a normal cigarette with filters of low to moderate effectiveness, and to reduce the specific tar content in the smoke by ventilation instead of filtration (patent specification page 2, right-hand column, lines 40-43). An opinion on this stated object is given on page 12 below.

Evidence submitted:

Annex 5: Swiss Patent Specification No. 645,252

(Johnson)

6. The Defendant applied for two further patents early in 1983 for a modified Barclay filter, namely under No. 583/83 for a smoke filter, for which a British priority of 2nd February 1982 was claimed, and under No. 452/83 a cigarette filter, for which American-priority of 16th February 1982 was claimed. Both applications resulted in the grant of a Swiss/Liechtenstein Patent, namely patent No. 657,755 (hereinafter briefly referred to as the Luke Patent, after the inventor, or the second patent in dispute) in respect of application No. 583/83, and patent No. 658,775 (hereinafter briefly referred to as the Lamb Patent, after the inventor, or the third patent in dispute) in respect of application No. 452/83.

Both the second and third patents in dispute relate to cigarette filters which possess separate circumferential or peripheral ventilation and are therefore intended to improve the quality of the tobacco smoke as perceived by the smoker. Despite an identical stated object, the two patents nevertheless differ in respect of the possible solutions proposed, the third patent in dispute describing a sealing-off of the ventilation grooves from the inside of the filter plug, which is absent in the second patent in dispute. Further reference will

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be made to details below.

Evidence submitted:

Annex 6: Swiss Patent Specification 657,755 (Luke)

Annex 7: Swiss Patent Specification 658,775 (Lamb)

I. On the Johnson Patent No. 645,252

7. Characterising elements of the patented cigarette filter according to Swiss Patent Specification 645,252 (Johnson) are

- a) a porous filter rod (2) of cylindrical shape, also referred to in the patent specification as a filter element (10, 20, 30, 40);
- b) a non-porous wrapping sheet (12; 22, 32, 42), which extends along the rod (2) and wraps the latter, but leaves the ends thereof open for free flow;
- c) a plurality of longitudinally extending and peripherally distributed, mutually spaced grooves (14; 24, 34b, 44a) possessed by the wrapping sheet (12) and the rod (2), which extend over a certain length starting from at least one end,
- d) a tip material (16), also referred to as tip paper in the patent specification, which extends in the longitudinal direction and envelops the wrapping sheet (12), this tip material (16) being permeable to air, which makes it possible for the ventilation air to flow through the tip material into the grooves;
- e) the stated effect, according to which this air is the only fluid which flows through these grooves when a smoker draws normally on a cigarette fitted with this filter.

Further claims envisage

- aa) that the grooves (14) starting from at least one end of the filter rod (2) are open at this end (Claim 2);
- bb) that the grooves (14) extend over a length which is less than the length of the filter rod (2) (Claim 2);
- cc) that the tip material (16) possesses perforations (18; 48) which are connected for the purposes of flow with the grooves (14; 44a, 44b) (Claims 2 and 4);

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- dd) that the tip material (16) is permeable to air and preferably in sheet form (Claim 3);
- ee) that the grooves (14; 24; 34a; 44a, 44b) are arranged in particular geometric manner (Claims 5-7, 9, and 10);
- ff) that the wrapping sheet (12) which is non-porous for smoke and the porous filter rod (2) consist of a single piece (Claim 8);
- gg) cigarettes fitted with a cigarette filter of this type (Claims 9 and 10).

3. On the question of disclosure of the Johnson Patent

8. The description of the invention is an essential constituent both of the patent application and of the patent specification (Article 49, Section 2, Clause b, 51 Section 3, 63 Section 2 Patents Act, Article 26 Patent Rules). Thus, it cannot be a matter for the Applicant's discretion whether or not he will attach a description to his patent claims or what that description is to contain. The latter is also clear from Article 26, Section 5, Patent Rules, according to which the description must contain at least one exemplary embodiment of the invention. Hence the description must contain complete and clear details of the invention claimed (cf. Blum/Pedrazzini, Swiss Patent Law, No. 5b on Article 50, Patents Act), for which reason everything which is necessary for implementation of the patent applied for must be incorporated into the description. The description of the Johnson Patent fails, in more than one respect, to comply with this self-evident requirement for disclosure.
9. The Johnson Patent is based on a USA priority. In the relevant priority document, the wording relating to the wrapping sheet states that it consists of "non porous wrapper". This was later expanded in US Patent 4,256,122 to read: "non-porous or smoke impervious wrapper" (compare Abstract of the Patent Specification, line 2, and Claim 1, line 3, and also Claim 9, line 1). Regarding the tip material, this is stated to have "flow-through openings", in other words apertures.

Evidence submitted:

Annex 8 Photocopy of priority document, US 029,230

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of 11th April 1979

Annex 9 Photocopy of US Patent Specification 4,256,122
(Johnson)

In the Swiss Patent Claim 1, line 13 (cf. Annex 3) the wording is "this tip material 16 being permeable to air". The corresponding wording is also found in Patent Claim 3. The priority claimed is wrongly invoked, because of this evident discrepancy between the priority document, which refers to apertures, and the Swiss Patent Specification, which refers to permeability to air.

The wording in question is, moreover, not covered by the description of the exemplary embodiments, since all that is stated at that point is that perforations are provided in the so-called tip material 16 (cf. Annex 5, page 3, right-hand column, lines 14 and 29). Porosities can be permeable to air, and this can probably also be inferred from the description of the figures, but permeability to air is not always necessarily caused by porosities. The Applicant itself has acknowledged this distinction and in fact has even emphasised it in Claim 4.

The last feature of Claim 1, lines 15 to 18, is a statement of effect for which no support can be found in the description. In this context, all that is stated in the description, on page 3 of the patent specification, right-hand column, lines 16 to 19, is:

"During smoking, the ventilation air flows through the grooves 34b into the smoker's mouth and then flows simultaneously along through the grooves 34a into the tobacco rod 7 and the filter plug 6."

Corresponding wordings are also to be found in the same column, lines 27 to 29 and lines 56 to 60.

Nothing is said in the description of the exemplary embodiments to the effect that the air is the only fluid which flows in the grooves, and similarly it is not possible to infer from the description that this occurs only when the smoker draws normally on the cigarette, or what drawing normally is. The explanation for this is evidently that the statement of effect was not contained in the original application documents and was only

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introduced later into the patent claim and the description.

Evidence submitted:

Annex 10: Photocopy of unalterable copy of the patent claims and description

This effect can be achieved only if the wrapping sheet 12 is impermeable to smoke, since only then is it impossible for any smoke to pass from the inside of the filter rod 2 through the wrapping sheet 12 into the groove. However, this is not indicated in Claim 1, where it is merely stated that the wrapping sheet is not "porous" - compare line 2 of the same claim - which is not the same thing as "impermeable to smoke".

In the claims and also in the description the terms "porous" and "perforation" are used in different senses. Porosities can be permeable to air and/or permeable to smoke. The effect which a porosity of this type has depends on its quality. The Defendant in this action for revocation has recognised that there are differences here, and has consequently, for example as in Claim 2 and Claim 8, drawn distinctions with the wording "not porous for smoke" on the one hand and "porous" on the other hand.

The characterisation selected in Claims 2 and 8 for the wrapping sheet 12, according to which the latter is qualified as "not porous for smoke", is not disclosed in the description. Whereas in Claim 1 the expression "not porous" has evidently been assumed to mean "impermeable", a special qualification of the porosities is now introduced in Claim 2, a qualification moreover which finds no support in the description. Later in the same claim it is stated "that the wrapping sheet is impermeable to smoke". This again is nowhere indicated in the patent description. All that is stated there is that the wrapping sheet is not porous - compare, for example, page 3, left-hand column, line 30.

With regard to Claim 3, it must be noted that a tip material which is "permeable to air" is not disclosed in the description, nor is such a material "in sheet form" disclosed there.

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In Claim 4 the term "airtight", which has not been disclosed in the description, is introduced, and it is stated there that the tip material is to be airtight and is to possess perforations. If perforations are equated with permeability to air, as occurs in Claim 1, then Claim 4 contains a contradiction.

In Claim 7 it is stated as the final characterising feature "that these two families of grooves (34a, 34b) are separated from one another as regards flow". This feature is assumed in the description of the statement of effect in connection with Figure 3, but not disclosed as such.

In Claim 8 the wrapping sheet is qualified as "not porous for smoke". As already mentioned above, this term is nowhere disclosed in the description.

If Claims 9 and 10 have any meaning, they derive as a matter of course from the wording of Claim 1 and contain no special characterisation. However, if it were conceivable for an embodiment in accordance with Claim 1 not to comply, as a matter of course, with the features according to Claims 9 and 10, then at any rate no such embodiment can be derived from any part of the patent specification.

The stated object on page 2, right-hand column, lines 40 et seq. is incomprehensible. The Applicant departed from this incomprehensible statement of object in its German Patent Application P 30 11 959.6-23, running for the same period and based on the same priority, which led to Patent 3,011,959. The statement of object formulated there (page 2) reads:

"The object of the present invention is to design a cigarette filter of the type explained initially, in such a manner that, while the high level of reduction of undesirable substances and the good processability on conventional cigarette-making machines is retained, a cigarette with a more intensive tobacco flavour is obtained."

Evidence submitted:

Annex 11: Photocopy of description from Patent DE 30 11 959

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dated 27th October 1982 (Johnson)

The Patent Owner also caused this stated object to be expressed, not by chance, in the German application. In this connection, in fact, on page 10, lines 7 to 15, of its submission of 15th January 1982, the Patent Owner is represented as stating:

"that it is evidently crucial for the intended effect that pure streams of air be generated around the periphery of the filter body. Apparently, only these attain a sufficiently high rate of flow to produce a turbulent, whipping movement of the smoke emerging from the end surface of the filter body nearer the mouth, which movement propels the smoke to the organs of taste in the mouth."

Evidence submitted:

Annex 12: Photocopy of the submission by Dr. H. Kinkeldey, Patent Agent, of 15th January 1982 for Brown & Williamson to 10 W (pat) 88/81 (P 30 11 959.6.-23)

An invention does in fact also require a stated object, the indicated solution being linked to this object by a causal relationship, and this is lacking in the present patent.

4. On the parallel German Johnson Patent 3,011,959

10. Under German patent law, the patentability necessary for the granting of a patent is evaluated in accordance with criteria very similar to those to be applied here. It is therefore worthwhile at this point to consider briefly the granting procedure for the parallel German Johnson Patent 30 11 959, which is based on the same convention priority and whose original documents are a translation of the same English-language original as used for the present first patent in dispute.

First, the German Johnson Patent was in the first instance rejected by the German Patent Office by an official decision of 31st July 1981. It was subsequently granted, on appeal by the Applicant, by the Federal Patent Court, according to a judgment of 27th October 1982.

Evidence submitted:

Annex 13: Official decision of the German Patent Office

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dated 31st July 1981 with reference to
P 30 11 959.6-23

Annex 14: Decision of the Federal Patent Court on appeal
by Applicant, dated 27th October 1982 with
reference to Patent 30 11 959.6-23

An opposition was thereupon filed by a number of parties, including the Plaintiff in the present action of revocation, and the patent was then declared void by the Opposition Division according to official decision of 5th November 1984. The Defendant in the present action of revocation has lodged an appeal against this official decision. This appeal was unsuccessful, and in fact the Federal Patent Court again rejected the patent on 11th March 1986. An application for review made to the Federal Court of Justice is still pending.

Evidence submitted:

Annex 15: Official decision of the German Patent Office
dated 5th November 1984 with reference to
Patent 30 11 959

Annex 16: Judgment of the German Federal Patent Court
of 11th March 1986 with reference to Patent 30 11 959

In the decision to grant, German Auslegeschrift 2,107,850 (cf. Annex 14, page 7), which was cited in opposition, was evaluated in the following words:

"The skilled reader could thus derive from this printed publication the teaching that arrangements of grooves which are open or closed at the tip end or at the tobacco end are equally suitable for achieving the object stated therein (effective filtering and smoke dilution). He would also be reinforced in this interpretation by the fact that although, according to column 4, line 42, the dilution of the smoke takes place within the smoker's mouth, yet according to column 5, lines 33 to 35, by contrast, some of the air enters into the perforation (14 in Fig. 1) in the tube (3 in Fig. 1) and there mixes with the tobacco smoke - in other words, does so before entering the smoker's mouth. Thus, according to the state of the art, no special significance whatsoever has been attributed

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to the location in which air and tobacco smoke are brought together, whether inside or outside the filter."

The exceptionally favourable decision by the Federal Patent Court is thus based on an argument which, interestingly, coincides as to content with the feature which was admittedly added, as compared with the original patent claim, in the last three lines (left-hand column, lines 15-18) of Patent Claim 1 of Swiss Patent 645,252, but is not supported in the description of the exemplary embodiments (cf. above, pp. 9 et seq.).

The revocation of German Patent 30 11 959 by the German Patent Office on 5th November 1984 (Annex 15), which took place in the opposition proceedings, is based on German Offenlegungsschrift 2,849,904 (known as the Filosa Patent, belonging to Philip Morris) which was cited there but was not a prior publication.

Evidence submitted:

Annex 17: German Offenlegungsschrift 2,849,904 dated 23rd May 1979 (Filosa)

11. This Filosa patent is to be evaluated as state of the art under German law, in contradistinction to Swiss law, where this German Offenlegungsschrift 2,849,904 (which corresponds to the Swiss parallel Application 11 762/78 (= No. 633 421)), since it is not a prior publication with reference to the priority claimed, is not evaluated as state of the art. In conflict with this, however, the priority has been wrongly claimed, as stated above under heading 9. Since the said German Offenlegungsschrift 2,849,904 (Filosa) was published in the priority interval, this is a prior publication, since the priority is not valid.

Quite independently of this, what is defined in the previously published patent claims can, under the new Swiss Law (Article 7a, Patents Act) be destructive of the novelty of an invention of later priority (so-called prior claim approach) even if the priority had been rightly claimed. Since the essential intention here is to prohibit double patenting, the teaching is based on

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the assumption that only the published claims of Swiss patents are destructive of novelty (Official Gazette 1976 II 70; Pedrazzini, Patent- und Lizenzvertragsrecht [Law Relating to Patents and Licence Agreements], page 51). This is however of no significance, since a parallel patent to German Offenlegungsschrift 2,849,904, of identical content, exists in Switzerland, namely Swiss Patent 633,421 (Filosa).

Evidence submitted:

Annex 18: Swiss Patent 633,421 dated 15th December 1982 (Filosa)

The German Opposition Division needed to go no further than evaluating this single citation, as this single citation in itself sufficed to destroy the German patent completely (cf. Annex 15, page 4 et seq.).

Like the Swiss Filosa patent, German Offenlegungsschrift 2,849,904 (Filosa), cited in Germany, derives from a USA priority (US 843,146 of 18th November 1977), from which German Patent Application 2,858,154 also derives by division. This last-named patent application is a divisional application from German Patent Application P 2,849,904, and consequently contains no information which was not previously contained in German Offenlegungsschrift 2,849,904. On the basis of this divisional application, a Claim 1 was formulated which is identical with Patent Claim 1 of the German Johnson Patent 3,011,959. This Claim 1 of the German divisional application by Philip Morris was rejected by the German Patent Office in an official decision of 6th October 1983, the reason for the rejection being lack of inventiveness on the basis of German Auslegungsschrift 1,936,429 and German Patent 1,657,261, and also U.S. Patent 1,718,122.

Evidence submitted:

Annex 19: German Patent Application P 2,858,154

Annex 20: Official decision rejecting German Patent

Application P 2,858,154 of 6th October 1983

The rejected Philip Morris Division Application P 2,858,154 derives from an earlier priority than the Swiss Johnson Patent 645,252. If, according to the

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decision of the German Patent Office, Claim 1 of Division Application P 2,858,154 is not patentable due to lack of inventiveness, then this certainly applies to the identically worded Patent Claim 1 of the German Johnson Patent 3,011,959, which in fact has a later priority. These facts can logically be extended to the evaluation of the disputed Swiss Johnson Patent 645,252, which is essentially identical as to content with the parallel German Patent 3,011,959. The citations on which the official decision of 6th October 1983 (Annex 20), in the matter of the German Division Application P 2,858,154 is based, all form part of the state of the art under Swiss law. Detailed reference will be made to this in due course.

5. On Swiss Patent 633,421 (Filosa), which is destructive of novelty

12. The German Filosa Patent 2,849,904 (Annex 17), from which the abovementioned German Patent Application P 2,858,154 is a divisional application, of the same priority, corresponds - as already explained on page 18 above - to Swiss Patent 633,421 (also Filosa Patent). Although this patent is not a prior publication relative to the disputed Patent 645,252, its earlier application date means that it can destroy the novelty of the disputed patent if its claims are identical with those of the disputed patent. It is therefore necessary to examine whether the claims of the first disputed Patent 645,252 coincide with the claims of the Filosa Patent 633,421. This leads us to consider again the features of the disputed patent as singled out on pages 6 et seq. above. For the sake of simplicity, the same subdivision is again used here. The detailed findings are as follows:
- | | |
|------------------------------|-----------------------------|
| No. 645,252 (Johnson Patent) | No. 633,421 (Filosa Patent) |
| Precharacterising clause | |

- | | |
|--|--|
| a) a porous filter rod of cylindrical form | a) rod of smoking material having attached thereto a filter of lesser cross-sectional surface than that of the rod (Claim 1) |
|--|--|

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b) a non-porous wrapping sheet, which wraps the filter rod but leaves the ends thereof free.

c) plurality of longitudinally extending grooves which extend from at least one end over a certain length of the wrapping sheet

d) tip material which envelops the wrapping sheet, the said material being permeable to air, which makes it possible for ventilation air to flow through the tip material into the grooves

e) air is the only fluid which flows through the grooves

Characterising part:

aa) grooves are open at one exit end

bb) grooves do not extend over the entire length of the filter

cc) tip material possesses perforations which are connected with the grooves for flow purposes

b) filter is located in cylindrical aperture which passes axially through the tip made from material which is impermeable to smoke (Claim 4)

c) tip possesses at least one separate ventilation passage in the longitudinal direction of the tip from the inlet to the exit end of the tip (Claim 6)

d) tip possesses at least one air inlet in its outer wall (Claim 5). This air inlet may be a plug which is porous in the radial direction (Claim 7)

e) ventilation passages serve to introduce air directly into the smoker's mouth (Claims 6 and 12)

aa) ventilation passages terminate at the exit end of the tip (Claim 6)

bb) air inlet is in the outer wall of the tip (Claim 5), which means that the ventilation passages do not extend over the entire length of the tip or of the filter

cc) ventilation passages are connected with lateral air inlets for flow purposes (Claims 6 and 8)

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dd) tip material is permeable to air and preferably in sheet form

ee) grooves are arranged in a particular geometrical way

ff) the wrapping sheet and the filter rod consist of a single piece

gg) cigarettes fitted with a filter of this type

dd) tip material has lateral air inlets (Claims 6 and 8)

gg) cigarettes having such filters (Claims 1-7, 10)

It becomes clear from this comparison that, with the exception of the completely irrelevant particular geometrical arrangement of the grooves and the unity of wrapping sheet and filter rod, all features of the first disputed patent can be derived in their full extent and identically from the claims of the Filosa patent. All essential features of the Johnson patent are thus contained in this citation. Hence its novelty - with the exception of the particular geometrical arrangement of the ventilation passages and the joining of the wrapping sheet and filter rod - is destroyed. This is also clearly the case if the claims of the Johnson patent are rewritten in the terminology of the Filosa patent, replacing the terms filter rod (2) by filter (12), wrapping sheet (12) by plug (13), groove (14) by passage (25), tip material (16) by paper (23) and cigarette rod (9) by rod (10). If this is done, the claims of the Johnson patent read approximately as follows:

1. Cigarette which consists of a rod of smoking material and a cigarette filter attached thereto, characterised by a porous filter (12) of cylindrical form, a non-porous plug (13) which extends along the filter (12) and envelops the latter, but leaves the ends thereof open for a free flow, the plug (13) ... possessing a plurality of longitudinally extending, peripherally distributed, mutually spaced passages (25) by means of which the cross-sectional area of the filter is reduced to a cross-sectional area which is smaller than that of the rod of

smoking material, and these passages (25), starting from at least one end, extend over a certain length, and further characterised by paper (23) which extends in the longitudinal direction and envelops the plug (13), this paper (23) possessing perforations (24) which enable the ventilation air to flow through the paper (23) into the passages (25), this air being the only fluid which flows through these passages (25) when a smoker draws normally on a cigarette fitted with this filter.

2. Cigarette according to Claim 1, characterised in that the plug (13) is non-porous for smoke, and that it (13), starting from one end, extends along the filter (12), and in that the passages (25), starting from at least one end, are open at this end and extend over a length which is less than the length of the filter (12), the part of the plug (13) possessing the passages (25) remaining impermeable to smoke, and in that the paper (23) possesses perforations (24) which are connected for flow purposes to the passages (25).

3. Cigarette according to Claim 1, characterised in that the paper (23) possesses perforations (24) and is preferably in sheet form.

4. Cigarette according to Claim 1, characterised in that the paper (23) is airtight and preferably in sheet form, and in that the paper (23) possesses predetermined perforations (24) which are connected for flow purposes with the passages (25).

5. Cigarette according to Claim 1, characterised in that the passages (25) are arranged at an angle relative to the longitudinal axis of the filter.

6. -----

7. -----

8. Cigarette according to Claim 1, characterised in that the plug (13) which is non-porous for smoke and the porous filter (12) consist of a single piece.

9. Cigarette according to Claim 1, characterised in ... that the filter (12) is connected for flow purposes with the rod (10).

10. Cigarette according to Claim 1, characterised in

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that ... the ... passages (25) of the plug (13) are connected for flow purposes with the smoker's mouth.

Exactly the same claims can be derived from Swiss Patent 633,421 (Filosa patent), if they are restricted in the sense of the action for partial revocation according to Article 27 of the Patents Act. Such a restriction could be undertaken by the judge at any time, the patent being restricted to the abovementioned claims. It would be difficult to demonstrate more clearly than is done by the above wording that the prior Filosa patent is catastrophically damaging to the novelty of the disputed patent. It essentially contains all features of Claims 1-5 and 8-10 of the patent in dispute, virtually verbatim. As if this were not sufficient, Figure 7 of the Filosa patent illustrates the mode of action of the disputed patent in virtually identical terms. The patentee of the Filosa patent therefore only recently caused the Filosa patent to be restricted, as a result of which the coincidence of the claim with the claims of the first disputed patent was even more apparent.

Evidence submitted:

Annex 21: Declaration of partial abandonment of
Swiss Patent Specification 633,421
(Filosa)

13. The essential features of the Johnson Patent are also the subject of the remaining claims of the restricted Filosa patent 633,421, as is apparent from the comparison which follows, in which for the sake of simplicity the same subdivision as used initially has again been selected:

Johnson Patent

restricted Filosa patent

Precharacterizing clause:

a) A porous filter rod of cylindrical form

a) .."a rod of smoking material and a filter attached thereto"... (Claim 1)

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- b) A non-porous wrapping sheet, which wraps the filter rod but leaves the ends thereof free
- b) .."a non-porous plug 13, which extends along the filter element 12 and wraps the latter, the ends thereof being free for flow".. (Claim 1)
- c) Plurality of longitudinally extending grooves which correspond to one another from at least one end over a certain length of the wrapping sheet
- c) .."possesses a plurality of longitudinally extending and circumferentially distributed passages 25, these passages 25 starting from the tip end do not extend fully to the tobacco end".. (Claim 1)
- d) Tip material which envelopes the wrapping sheet, the said material being permeable to air, which makes it possible for the ventilation air to flow through the tip material into the grooves
- d) .."a tip paper 23 is provided, which wraps the plug 13 and is of perforated design, which makes it possible for air ... to flow into these passages" (Claim 1)
- e) Air is the only fluid which flows through the grooves
- e) .."that air 21 is the only medium which .. flows into these passages" (Claim 1)

Characterizing part:

- aa) Grooves are open at one exit end
- aa) .."the ends thereof being free for flow starting from the mouth end" (Claim 1)

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- bb) Grooves do not extend over entire length of the filter bb) .."do not extend fully to the tobacco end".... (Claim 1)
- cc) Tip material possesses perforations which are connected with the grooves for flow purposes cc) .."which wraps the plug and is of perforated design".... Claim 1)
- dd) Tip material is permeable to air and preferably in sheet form dd) "Tip paper 23.. which.. is of perforated design" Claim 1)

Hence all the essential features of the Johnson Patent are also anticipated by the restricted Filosa patent.

Claim 1 of the Johnson patent, as set out above, has admittedly been extended to include the statement that, owing to the passages, the cross-sectional area of the filter is reduced to an area which is smaller than that of the rod of smoking material. This added feature, which is to be found in Claim 1 of the Filosa patent, is however also present in the Johnson patent, since the cross-sectional area of the filter element in that patent is reduced in comparison to the cross-sectional area of the tobacco rod by the presence of the grooves, being in fact reduced by the cross-section of the grooves. The content of the individual claims of the Johnson patent - with the exception of Claims 6 and 7 - is thus virtually identical in wording with the claims of the Filosa patent. The first disputed patent thus lacks novelty in the sense of Article 7a of the Patents Act.

6. On Swiss Patent 470,145 (Osmalov), which is destructive of novelty

14. The Osmalov patent, which likewise belongs to Philip Morris, derives from an American priority of 20th April 1967 and is hence clearly prior to the disputed patent. The American parallel

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patent 3,490,461 was granted on 20th January 1970. The German parallel patent 1,657,261 was laid open on 3rd February 1972 and granted in the same scope on 7th September 1972. In the case of the German Osmalov patent, however, in comparison with the American patent, the drawings and the associated text do not coincide. The Swiss Osmalov patent 470,145 was granted on the 31st March 1969 and published on 14th May 1969.

Evidence submitted:

Annex 22: US Patent 3,490,461 dated 20th January 1970 (Osmalov)

Annex 23: German Patent 1,657,261 dated 7th September 1972 (Osmalov)

Annex 24: Swiss Patent 470,145 dated 14th May 1969 (Osmalov)

15. The main claim and characterizing features of the Osmalov patent are listed in more detail below and compared with the disputed patent 645,252:
- a) The tip consists of a cylindrical member which lies in the same alignment as the tobacco rod (smoking material).
 - b) It possesses a continuous longitudinal passage.
 - c) The outer part of the cylindrical member possesses air supply passages extending in the longitudinal direction.
 - d) The air from the air supply passages mixes only in the smoker's mouth.
 - e) The cylindrical member consists of an integral plastic member.

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- f) The plastic member is enclosed by an outer wrapping.
- g) The outer wrapping has air entry apertures which are distributed towards the periphery in the region of the ends of the air supply passages.

If we compare these features with the disputed patent, the following result is obtained:

- a) Element a) has been adopted identically.
- b) Element b) is likewise present.
The longitudinal passage is admittedly not empty in the disputed patent but is filled with filter material. However, Osmalov in no way insists that the continuous longitudinal passage must be hollow; it can also very well consist of material which is permeable to smoke, such as for example a filter rod. Accordingly, in the American Osmalov patent (Annex 22) reference is made not to a "channel" but to a "passage".
- c) The air supply channels c) extending in the longitudinal direction outwardly within the cylindrical member correspond to the plurality of longitudinally extending grooves in the first disputed patent.
- d) In the first disputed patent, likewise, the air from the air grooves mixes with the smoke only in the smokers mouth, the smoke flowing from the tobacco rod through the cylindrical member (feature d). This is apparent from the mode of action indicated in the first disputed patent, according to which the ventilation air is the only fluid which flows

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through the air supply channels "when a smoker draws normally".

- e) The plastic member according to feature e) corresponds to the non-porous wrapping sheet (12) in the first disputed patent, which wraps the space with the filter rod.
- f) The outer wrapping f) is identical with the tip paper (16) of the first disputed patent, which wraps the wrapping sheet and the air grooves.
- g) Air entry apertures according to feature g) are present in the first disputed patent to the extent that the tip paper is intended to be permeable to air, which makes it possible for the ventilation air to flow through the tip material into the grooves/air supply channels.

The first disputed patent thus possesses all features of the Osmalov patent, if it is assumed that the cylindrical member need not be hollow but can also be filled with porous filter material. The replacement of the hollow tip with a filter-filled tip appears to be completely irrelevant and secondary, particularly when it is considered that filter cigarettes were known long before the 1970's and enjoy great popularity. The Osmalov patent therefore anticipates the characterizing elements of the disputed patent in a manner which is destructive of novelty.

7. On the level of inventiveness as compared with the state of the art

- 16. Even if one were to accept the presumption - as does the German Patent Court (cf. Annex 16, p.11, middle) - that the prior Philip Morris patent is not damaging to the novelty

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of the disputed patent, it would nevertheless be necessary to deny the validity of the latter since its content derives in an obvious manner from the state of the art (Article 1, Section 2, Patents Act).

The following are cited as state of the art:

Evidence submitted

Annex 25: German Auslegeschrift 1,936,429 (Thomson)

Annex 26: German Offenlegungsschrift 2,048,432 (Kroeger)

Annex 27: German Auslegeschrift 2,107,850 (Byrne)

Annex 28: German Auslegeschrift 1,692,945 (Raban)

Annex 29: German Offenlegungsschrift 2,711,784 (Luke A)

Annex 30: U.S. Patent 1,718,122 (de Shon)

Annex 31: U.S. Patent 3,390,684 (Hudnell)

Annex 32: U.S. Patent 3,324,862 (de Simone)

Annex 33: German Offenlegungsschrift 2,711,742 (Luke B)

Annex 34: German Offenlegungsschrift 2,135,903 (Labbe)

17. In the treatment of the individual patent claims which follows, despite the contradictory wording "porous", permeable to air", etc., the said patent claims are deemed to have a content corresponding to the functional statement of effect subsequently added to Patent Claim 1 of Swiss Patent 645,252 - cf. lines 15 to 19 of that patent - since otherwise no comparative consideration is logically feasible.

a) Re Patent Claim 1

18. The lack of inventiveness is already apparent from the reasons for the German decision to reject the patent (Annex 16). Express reference is therefore made here to the remarks and considerations contained in that judgment.
17. It is apparent from US Patent 3,490,461 (Annex 22, Osmalov) - compare column 5, lines 26 to 30 - that the ventilation stream is intended to be separate from the smoke stream. In column 5, lines 41 to 43, it is stated that the intention is to use a barrier 31 which is impermeable to smoke in order to separate the smoke stream from the ventilation stream. From column 6, lines 16 to 17, it is apparent that the filter compartment 101 in Figure 2 can also extend over the entire length of the tip. In column 8, lines 74 to column 9, line 15 it is stated

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that the cavity in the tip can be filled with filter material. In column 4, lines 31 to 37, a thin tip 18 is recommended and this corresponds to a covering sheet. Such a covering sheet is specifically claimed in column 6, lines 43 to 47.

If the filter in Figure 4 is employed with the passages in Figure 1, and the barrier 31 is used, the result is the subject of the application and in fact the identical exemplary embodiment according to Figure 4 of the Swiss Johnson Patent 645,252. If a thin covering sheet is significant, then Figure 8 is used instead of item 18 in Figure 1 of US Patent 3,490,461 (Osmalov). The average person skilled in the art, therefore, needs to do no more than he is instructed in this US Patent 3,490,461 in order to arrive at the subject of the application of the Swiss Johnson Patent No. 645,252. The Federal Patent Court also arrives at this conclusion (cf. Annex 16, page 13).

20. German Offenlegungsschrift 2,849,904 (Filosa, Annex 17) was published in the priority interval and is therefore to be evaluated as a prior publication, since, as stated above, the priority was wrongly claimed. Figure 7 of this German Offenlegungsschrift shows a cigarette which is identical with Figure 4 of the Swiss Johnson Patent 645,252, with the single difference that a plug 6 is provided instead of a covering sheet. This difference however is not supported in the disclosure of the Johnson Patent 645,252. Moreover, by using Figure 8 from US Patent 3,490,461 Osmalov, (Annex 22) or Figure 5 of German Auslegeschrift 2,107,850 (Annex 27) instead of the plug 6 produces the exemplary embodiment shown.

Moreover, a thin covering sheet is also claimed in German Offenlegungsschrift 2,849,904 (Filosa), page 7, lines 18 to 24, where it is stated that: the cross-section of the filter 12 "amounts to about 30 to 90% of that of the rod 10 and may be of any suitable geometrical form and design". 90% is equivalent to the thickness of the thick covering sheet.

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21. The novelty is destroyed by German Auslegeschrift 1,936,429 (Annex 25, Thomson). In this German Auslegeschrift a cigarette filter rod is described. A cigarette filter produced from this cigarette filter rod is wrapped in a thin-walled outer plastic wrapper 12 (compare column 4, lines 44 and 45). The plastic wrapper 12 consists of polyethylene (compare Claim 12). Although it is not stated that the plastic wrapper 12 is impermeable to air, it is nevertheless known that polyethylene films are impermeable to air. The fact that the plastic wrapper 12 is in fact impermeable to air also emerges from the statements in column 5, lines 3 to 8. Otherwise, how else could the dilution air be supplied to the smoker's mouth separately from the stream of smoke, as is there stated?

The filter according to Figure 3 is filled with filter material over its entire length, as is evident from the production method indicated according to Figure 1. In column 4 below, reference is expressly made to Figure 3 of U.S. Patent Application 632,336 (Osmalov). This U.S. patent application resulted in U.S. Patent 3,490,461 (Annex 22) to which German Patent 1,657,261 (Annex 23) corresponds.

The reader of German Auslegeschrift 1,936,429 (Annex 25, Thomson) is thus also asked to take into consideration U.S. Patent Application 632,336 (Osmalov) or, which is the same thing in terms of content, German Patent 1,657,261 (Annex 23). If he complies with this suggestion, then he arrives at the subject of the application, if in fact, in accordance with this suggestion, he exchanges the tip 18 in Figure 1 of 1,657,261 (Annex 23) for a filter rod section from 1,936,429 (Annex 25), Figure 3, and in doing so makes the seal 31 from Osmalov (Annex 23). The result thus obtained - the separation of the main flow of smoke from the ventilation air - is indicated in German Auslegeschrift 1,936,429 (Annex 25) in direct association with the request - compare column 5, lines 3 to 8, in that reference.

22. German Offenlegungsschrift 2,048,432 (Annex 26, Kroeger) shows under Figs. 1 and 2 a filter cigarette having a

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cigarette filter 20, which possesses axially extending grooves 27 and 29 on the periphery, these grooves being closed at the tobacco rod end and open at the mouth end, as a result of which the smoke is constrained "without passing through the actual filter, to flow through the peripheral longitudinal passages 27 and 29 thereof" (cf. page 8 of the Offenlegungsschrift, lines 2-4). The outer passages 29, which are restricted internally by the central element 25 and externally by the outer element 23, convey ventilation air, if the outer element (as indicated on page 5, 1st paragraph) is permeable to air. As regards the inner element 24, it is stated that it is permeable to air. As regards the middle element 25, it is stated at the bottom of page 8, that it is intended to be impermeable to air. This also corresponds to the conclusion in the last subordinate clause of Claim 1 of the disputed Patent 645,252. On page 8, 2nd paragraph of German Offenlegungsschrift 2,048,432 (Annex 26) it is stated that the central element is preferably an injection-moulded plastic component and that this is impermeable to air. That this is the case, and is intended to be the case, is evident from the conclusion at the end of the 2nd paragraph of page 8, where it is stated "that the secondary air - by which is meant the ventilation air drawn in through passages 29 - can be guided parallel to the principal stream of smoke, but without mixing with the latter".

The middle element 25 corresponds to the wrapping sheet 12 from the Patent Claim 1 of the first disputed patent 645,252, with the same aerodynamic consequences for the effect of the grooves. The granted Claim 1 is thus anticipated in a manner which is destructive of novelty.

Similar considerations also result from somewhat closer analysis of the claims listed in German Offenlegungsschrift 2,048,432.

Claim 1 - "that the inner element 24 forms, with the middle element 25, passages 27 such that tobacco smoke

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passing through the inner element into these can be led away through them, these passages 27 are closed at the tobacco side ..."

Claim 2 - "that the inner element 24 consists of material which is permeable to air, such as bound filaments, fibres, strips, plastic foams ..."

Claim 10 - "that the passages 29 formed by the middle element 25 with the outer element 23 are closed on the tobacco side"

Claim 14 - "that the substances of the material of the inner element 24 " are contained in the inner passage 27

Claim 15 - "that air flows through apertures in the outer element into the passages 29 formed by the middle element 25 with the outer element 23 and is led away through these passages"

Claim 22 - "that the middle element 25 is produced from one or more endless strips, in a manner such that it is impermeable overall to air".

If, in accordance with Claim 2, the inner element 24 and the inner passages 27 are assigned to the Barclay filter member 2, and the middle element 25 is assigned to the Barclay covering sheet 12, the result is identical with the exemplary embodiment according to Figure 4 of the disputed patent 645,252.

23. German Auslegeschrift 2,107,850 (Annex 27, Byrne), in the opinion of the Federal Patent Court (Annex 16, page 13) discloses a filter which is suitable for series manufacture as a bulk product and combines the streams of air and smoke only at the smoker's mouth. For the Federal Patent Court, it is apparent, and requires no inventive effort, that the filter in Figure 5 of this Auslegeschrift must be porous and that the groups of the remaining filter material must be separated by a non-porous zone. According to German Auslegeschrift 2,107,850 (Annex 27, Byrne), in the area of the grooves, which is all that matters, the material is shown in Figure 5 as being compressed at the periphery, if the filter tip is produced in the manner indicated in column 6, lines 25 to 54, of this German

Auslegeschrift. In this production method the filter material, which has occupied in the blank the space later to be occupied by the grooves, has to be pressed into the surface which is thus compressed. The more densely the filter material is compressed, the less permeable it is to air.

In this context reference is again made to German Auslegeschrift 1,692,945, which discloses, in column 4, lines 41 to 47 (Annex 28, Raban) that, in the case of a filter, the surface can be sealed by sintering to form a dense skin. This is mentioned only to illustrate the result which the average expert could expect on reading column 6, lines 25 to 54.

Similar information is also obtained from German Offenlegungsschrift 2,711,784, page 13, 3rd paragraph (Annex 29, Luke A). There it is stated that, with the process technology in question, it is even possible to achieve superficial, complete sealing.

Absolute impermeability to air in the sense of a vacuum seal can perhaps not be achieved by the method of German Auslegeschrift 2,107,850 (Annex 27, Byrne), but a seal of this type is in fact probably also not implied in Swiss Patent 645,252 - all that can be meant is relative impermeability to air. That this is so is evident merely from the description of the exemplary embodiments, according to which the impermeability to air is achieved by means of a covering sheet which consists conventionally of paper and inevitably possesses a certain residual porosity. As regards the quality of the relative impermeability to air, all that can be inferred from the subsequently introduced feature of the claim is that the residual permeability to air of a covering sheet is intended to be substantially less than the permeability to air of the perforations 38 in the tip sheet 36.

If the perforations visible in Figures 1 and 2 of German Auslegeschrift 2,107,850 (Annex 27, Byrne) are now related to the seals resulting if the filter tip according to Figure 5 is produced in accordance with column 6, lines 5 to 54, the result is identity of characterisation

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and hence anticipation injurious to novelty.

The relativistic consideration in connection with the impermeability to air is also justified because the effect allegedly produced by the separation of ventilation air and main-stream smoke, if it should in fact occur, is also to be expected with minimum permeability to air of the peripheral surface.

Nowhere in Swiss Patent Specification 645,252 (Johnson) is it stated, nor could it be inferred, why a special effect achieved by means of this separation occurs only when the air seal is a total seal. If however relative separation leads to an advantageous effect (which in fact is still disputed), the extent of that effect is dependent on the quality of the impermeability to air. Then, however, it is obvious to improve this impermeability to air if it is desired to intensify the effect, particularly since the gas-tight separation of air and tobacco smoke is previously known from German Patent 1,657,261 (Osmalov, Annex 23).

24. U.S. Patent 1,718,122 (Annex 30, de Shon) shows ventilation passages 7, which are open towards the mouth end and are closed off from the main-stream smoke by the cigarette paper. In this case again the impermeability to air is only relative, in which connection reference is made to the remarks made above. The cigarette paper must be relatively impermeable to air, otherwise the cigarette would not draw. It is a fact, at any rate, that in this cigarette the ventilation air passes into the smoker's mouth separately from the main-stream smoke and cannot become mixed at an earlier stage. In fact the tip - that is to say, the region wrapped by the covering paper 8, is filled with tobacco fibres. These tobacco fibres in the tip, however, are not intended to be smoked, since the strong covering paper is unsmokable. Rather, the tobacco fibres in the tip serve the same purpose as the filter in the granted patent claim, namely to filter the main-stream smoke. Nothing in Swiss Patent 645,252 excludes the use of tobacco fibres as filter material in the tip. Nor is it possible to discern how anything at

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all could change in the action asserted by the Patent Owner if the tip is filled with acetate filter material or with tobacco fibres. This U.S. patent specification, too, anticipates Claim 1 of the disputed patent in a manner injurious to novelty.

25. U.S. Patent 3,390,684 (Annex 31, Hudnell) shows a ventilation passage terminating at the mouth end, which guides ventilation air to the smoker's mouth separately from mainstream smoke. The secondary air passage according to Figures 5, 6 and 7, previously disclosed by this U.S. Patent, is compressible and is intended to be compressed by the smoker when the smoker wishes to shut off the ventilation air. This, however, only makes sense provided that it is impossible, when the passage is compressed, for ventilation air to flow in anyhow at the aperture 32, pass through the covering sheet 12 and into the tip and reach the smoker's mouth from there. Another reason why this cannot occur is that the passage according to Figure 7 is lined on the inside by the covering sheet 12, which must necessarily, as stated above, have a sufficient relative impermeability to air for the cigarette to function. But, if this is the case, the average expert will be unlikely to think, on reading this patent specification, that the tube 41 could have walls which are permeable to air. The fact that the tube 41 is to be designed, in this case, so as to be impermeable to air is not indicated in the patent specification because it is an absolute matter of course for the reader.

Anything which is achieved in the way of flow effects by means of one groove is merely multiplied when a plurality of grooves are arranged to be distributed over the periphery. No difference justifying the grant of a patent can be found in this.

26. U.S. Patent 3,324,862 (Annex 32, de Simone) possesses grooves 34, 35 in the filter tip 33 - cf. Figures 5 and 6 - which communicate via perforations 37 with the outside air. This is intended to result in ventilation air passing into the smoker's mouth, as is stated in column 1, lines 50 and 51. The same purpose is served by the tubes

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according to Figure 1, which according to column 2, lines 28 and 29, can consist of paper, are consequently relatively airtight and seal off the inside of the tubes from the filter. To seal off the grooves according to Figure 5 from the filter in a corresponding manner is no invention, anymore than is the complete separation of the tubes from the tobacco smoke, as is realised according to Figures 3 and 4.

27. Claim 1 of the contested Johnson patent contains nothing which could justify patentability in respect of the citations.

b) Re Patent Claim 2

28. Claim 2 is anticipated, for example, by German Patent 1,657,261 (Osmalov, Annex 23). In that patent the part 18 corresponding to the wrapping sheet 12 is not porous. The grooves start from one end, namely the mouth end, and are open at this end, extending only over part of the length of the filter rod, and perforations 28 are provided which terminate in the grooves 22.

c) Re Patent Claim 3

29. Claim 3 is anticipated, for example, by German Patent 1,657,261 (Osmalov, Annex 23). According to German Patent 1,657,261 the wrapping sheet 24 corresponding to the tip material is porous - cf. column 5, line 9 - and, as the expression wrapping sheet implies, is in sheet form.

d) Re Patent Claim 4

30. Claim 4 is anticipated, for example, by U.S. Patent 3,390,684 (Annex 31, Hudnell). The wrapping sheet 13 according to Figure 7, corresponding to the tip material, has necessarily to be relatively airtight, since otherwise the intended effect of shutting off the ventilation air would be impossible to achieve. In Figures 8 and 9 a perforation 43 is visible.

e) Re Patent Claim 5

31. Claim 5 is anticipated, for example, by German Patent 1,657,261 (Osmalov, Annex 23), Figure 2, which shows helically wound grooves 131.

f) Re Patent Claim 6

32. Claim 6 is anticipated, for example, by German Offenle-

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gungsschrift 2,711,742 (Annex 33, Luke B), in which an annular channel 9 - cf. fourth page of description, penultimate paragraph - is provided which corresponds to the groove 26. A longitudinally extending, helical channel 7 (cf. the sentence of the description already referred to) starts from this annular channel 9.

g) Re Patent Claim 7

33. Claim 7 is anticipated, for example, by German Offenlegungsschrift 2,135,903 (Annex 34, Labbe), in which Figure 3 shows channels 10 and 12 corresponding to the grooves, these channels starting from different ends of the filter and being separated from one another as regards flow.

h) Re Patent Claim 8

34. Claim 8 is anticipated, for example, by German Auslegungsschrift 2,107,850 (Annex 27, Byrne) Figure 5 in connection with the sealing method described in column 6 and already dealt with above in relation with Claim 1.

i) Re Patent Claim 9

35. Claim 9 is anticipated, for example, by U.S. Patent 3,324,862 (Annex 32, de Simone) - cf. Figures 1 and 5 of this citation - according to which the passages formed by the grooves terminate at the cigarette rod.

k) Re Patent Claim 10

36. Claim 10 is anticipated, for example, by German Patent 1,657,261 (Annex 23, Osmalov) Figure 1, in which the channels 22 corresponding to the grooves terminate at the mouth end.

37. Since, as set out above, Claim 1 is anticipated in a manner injurious to novelty, the subsequent claims likewise present no additional new features which, in view of the demonstrated state of the art, could justify the patent if its scope were to be restricted.

II. On the Luke Patent + 657,755

8. On the question of disclosure of the Luke Patent

38. In accordance with the stated object of the Luke patent, it is intended, in the case of the filter

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having separate peripheral ventilation, to improve the quality of the tobacco smoke as perceived by the smoker (compare page 2, right-hand column, lines 3 to 10 and 55). This improvement is to be achieved by introducing an additional ventilation flow, which flows within the filter plug (compare page 3, right-hand column, lines 53 to 58). If this is to be the case, then the first ventilation flow must flow outside the plug and the second ventilation flow must flow separately therefrom within the plug.

The means necessary to ensure that the first ventilation flow flows only outside the plug and not also partly within the plug include a sealing-off of the walls of the grooves, as is also indicated on page 3, left-hand column, lines 12 to 15, for the first exemplary embodiment. This means of achieving the object is not however indicated in Claim 1, and moreover the subject of Claim 1 is not a solution to the stated object of the invention.

In this connection it should be pointed out that the wrapping 7 from Claim 1 is also designated in the description as tip 7 (compare page 3, left-hand column, lines 15 to 18), and elsewhere as wrapping (compare page 3, left-hand column, line 35).

Nor do the subclaims offer a means of achieving the object in this connection. According to Claim 4 a double wrapping could be provided, an external wrapping which is impermeable to air and an inner wrapping which is permeable to air. It is not stated that these wrappings are applied in a different manner, and for the purposes of the present consideration they may be treated, provided that they are applied jointly, as one

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wrapping which as a whole is impermeable to air but which does not prevent the entry of ventilation air from the passages 8 into the interior of the plug. Even if, as is not stated in Claim 4, the inner part of the wrapping is used to line the grooves (the outer part does not come into consideration for this, for geometrical reasons), this is not a solution, since it is precisely the inner part which is to be permeable to air, and which therefore does not provide the blocking necessary for separate peripheral ventilation.

The fact that this blocking of the grooves 5 from the interior of the plug 4 is also considered by the author of the Luke patent to be necessary for solving the object on which the invention is based is apparent from the fact that he has provided the said blocking for all the exemplary embodiments, namely:

- for the exemplary embodiment according to Figures 1 and 1A, by the sealing means according to page 3, left-hand column, line 13
- for the exemplary embodiment according to Figure 2, by the sealing means according to page 3, right-hand column, line 13, and
- for the exemplary embodiment according to Figure 3, by the impermeability to air of the first element according to page 3, right-hand column, line 51,

but no mention is made thereof in the claims. Therefore the claims do not characterize the alleged invention as it emerges from the wording of the object and from the means for achieving the said object indicated in the exemplary embodiment.

A delicate point in this context is that the third disputed patent, Swiss Patent 658,775 (Lamb),

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indicates a substantially identical object, but describes that same sealing of the groove which is absent from the present application as an important means for achieving the said object, this description having a priority which is 14 days later than that of the Luke patent (for further details, see below in connection with this third disputed patent).

9. On the parallel German Patent Application
P 3,303,299

39. German Patent application P 3,303,299 was filed on 1st February 1983, based on the same priority and having the same content. This application was rejected by a decision of 28th June 1984, based on the prior art consisting of:

German Auslegeschrift 1,960,364,
German Offenlegungsschrift 3,011,959,
German Offenlegungsschrift 2,828,208 and
German Offenlegungsschrift 2,209,763.

This rejection was not contested by the Defendant, and is legally valid according to a decision by the German Patent Office on the 11th September 1984.

Evidence submitted:

- Annex 35: Photocopy of official letter from German Patent Office of 31st January 1984
Annex 36: Photocopy of submission by Kinkeldey, Patent Agent, of 4th June 1984
Annex 37: Photocopy of new patent claims of 4th June 1984
Annex 38: Photocopy of German Patent Office rejection decision of 28th June 1984
Annex 39: Photocopy of declaration of legal validity of 11th September 1984

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40. In the examination proceedings, the Applicant was given the opportunity to delimit its patent claims on the basis of the ascertained state of the art. It took advantage of this opportunity by submitting 6 new claims of 4th June 1984 (cf. Annex 37). It applied to restrict Claim 1 to the embodiments according to Figures 2 and 3 with the annular recess 13 and 16 respectively. On the basis of this state of the art, therefore, the Applicant has already voluntarily abandoned the subjects of the claims corresponding to Claims 1 to 5 of the Swiss Luke Patent 657,755. It has even gone still further and has not confined itself to the peripheral passage 13 in accordance with Claim 6 of Swiss patent 657,755 (Luke), but has introduced as a further restricting feature the permeability to air of the side wall of the peripheral passage 13 on the mouth side - an important restriction, since a passage base which is permeable to air would in itself have sufficed for the intended purpose.

Despite these important restrictions the patent application was rejected, and the Applicant has refrained from exercising its right of appeal and has expressed itself as satisfied with this rejection - probably with good reason.

In connection with Patent Claim 1 of the second disputed patent, it should further be noted that the wording "making possible" is not a qualifying characterization of the "perforation" designated but contains a stated object, in that this perforation is intended to make the desired aim possible. It is left to the person skilled in the art, on reading this characterizing part, to determine for himself how he must make the perforations in order to achieve the desired effect.

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This is not, however, a patentable characterization.

10. On the level of inventiveness as compared with the state of the art

41. The following are cited as state of the art:

- 1) German Offenlegungsschrift 3,011,959
- 2) German Auslegeschrift 2,107,850
- 3) French Patent 1,531,543
- 4) German Offenlegungsschrift 2,849,904
- 5) German Patent 1,657,261
- 6) British Patent 2,095,532
- 7) US Patent 3,596,663
- 8) French patent 1,349,992
- 9) German Auslegeschrift 1,960,364
- 10) German Offenlegungsschrift 2,828,208
- 11) German Offenlegungsschrift 2,209,763

Evidence submitted:

Annex 11 German Offenlegungsschrift 3,011,959
(Johnson)

Annex 27 German Auslegeschrift 2,107,850 (Byrne)

Annex 40 French Patent 1,531,543 (Brochet)

Annex 17 German Offenlegungsschrift 2,849,904
(Filosa)

Annex 23 German Patent 1,657,261 (Osmalov)

Annex 41 British Patent 2,095,532 (Townsend)

Annex 42 US Patent 3,596,663 (Schultz)

Annex 43 French Patent 1,349,992 (O'Brien)

Annex 44 German Auslegeschrift 1,960,364 (Tomkin)

Annex 45 German Offenlegungsschrift 2,828,208
(Martin)

Annex 46 German Offenlegungsschrift 2,209,763
(Summers)

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42. a) Re Patent Claim 1

German Offenlegungsschrift 3,011,959 (Annex 11, Johnson): According to Figure 6 an air flow channel 44a is provided, which corresponds to the pre-characterizing part of the patent claim. It is open on the mouth side and communicates with aperture 48 in the wrapping 46. It is at a distance from the second, tobacco end of the plug. Through the passage 44a a first stream of air can pass directly to the smokers mouth, in accordance with the so-called separate peripheral ventilation to which the patentee refers on page 2, right-hand column, line 8.

According to Figure 6, furthermore, a passage 44b is provided which does not open into the mouth end but is sealed off from the mouth end by the cover sheet 42 which is not permeable to air (compare page 12, lines 10 and 11 of the citation, Annex 11: Johnson). This passage 44b opens out at the tobacco end and communicates with the perforations 48. In accordance with the statements made by the applicant for this citation, which applicant is identical with the Defendant, ventilation air flows both through the ducts 44a and through the ducts 44b - compare page 12, bottom. The ventilation air which flows through the ducts 44a passes directly into the smoker's mouth in the form of separate (first) peripheral ventilation. Ventilation air passes through the ducts 44b, drawn by vacuum, into the filter at the tobacco end thereof. This however is the second stream of environmental air which flows into the interior of the plug - meaning the filter.

This is a verbal anticipation of Claim 1, a fact

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which is unaffected by the word "directly" in Claim 1. The fact that this second ventilation stream passes along the tobacco rod is insignificant, quite apart from the fact that parts of this second ventilation stream also pass directly into the filter plug without contact with the tobacco rod.

German Auslegeschrift 2,107,850 (Annex 27, Byrne): According to Figure 1 an air flow passage is provided, to which passage a perforation 6 is allocated, so that a first ventilation stream flows in accordance with the precharacterizing clause of the patent claim. According to Figure 5, a filter is indicated, in which filter the corresponding passages do not extend to the tobacco end 51 - compare column 5, line 45. The cigarette of Figure 1 with the filter of Figure 5 corresponds to this extent to the precharacterizing clause of the patent claim. It also corresponds to the characterizing part, since ventilation air passes through the perforation 6 directly into the plug, which, since it consists of crimped cellulose acetate filaments (cf. column 6, line 13), is porous over its entire surface. The vacuum formed in the filter plug during drawing will thus necessarily suck ventilation air through the perforations not only along the passages but also directly into the plug, so that two ventilation streams are formed, one which flows via the passages directly into the smokers mouth, and a second which flows via the plug into the mouth.

French Patent 1,531,543 (Annex 40, Brochot): Figure 3 shows a cigarette having a filter tip, the outer, annular region 3 of which filter tip is filled with a flavouring agent. A first ventilation stream flows along this outer, annular

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region, finds access through the perforations 8 and passes into the smoker's mouth at the open, mouth end. A second ventilation stream flows through the perforations 8 and 9 into the inner region 2 which is filled with filter material, and through the filter material to the smoker's mouth. These again are two separate ventilation streams.

German Offenlegungsschrift 2,849,904 (Annex 17, Filosa): Figure 5 shows the cigarette having perforation apertures 24 in the outer wrapping 23 and having a central filter 12. Ventilation air flows through the apertures 24 in accordance with the arrows 21 into the filter 12, and from there to the smoker's mouth (cf. page 16, first paragraph). This is the second ventilation stream in accordance with the characterizing part of the patent claim. According to Figure 7 the aperture 244 leads into a passage which is arranged peripherally and is open at the mouth end. The ventilation air flows in accordance with the arrow 21 through this passage directly into the smoker's mouth, and does so separately from the main-stream smoke (cf. page 16, bottom). This corresponds to the precharacterizing clause of the patent claim. The entire patent claim is therefore anticipated by a combination of Figures 5 and 7 from this one patent specification.

British Patent 2,095,532 (Annex 41, Townsend) shows in Figure 3 a filter cigarette whose externally applied cover sheet 6 is impermeable to air (cf. page 2, right-hand column, lines 80 and 81). This cover sheet 6 is folded in the mouth region to give passages, which end at 8. Apertures 4 lead into these passages. The fact that the cover sheet 6 is actually folded in this

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way, although the reference numeral 6 does not appear at the mouth end is evident from the last sentence of the description. When it is stated there that the perforations 4 can also be omitted, and when as a modification the cover sheet 6 is permeable to air, then this sentence only has a meaning if the perforations 4 shown are actually in this cover sheet 6. This means that it is the cover sheet 6 which is folded. In the exemplary embodiment according to Figure 3, a first ventilation stream is formed which passes through the perforation 4 into the passages 7 and flows to the smoker's mouth, and a second ventilation stream is formed which enters the perforations 11 and flows through the filter material to the smoker's mouth. The mode of action and the means envisaged therefore are the same as in Patent Claim 1.

Patent Claim 1 of the Luke Patent is therefore anticipated by several printed publications, each in itself being destructive of novelty. The same also applies to an unformulated patent claim which would have contained the shortcoming referred to above in respect of the means of achieving the object, in connection with the sealing-off of the grooves 5.

b) Re Patent Claim 2.

43. According to German Offenlegungsschrift 3,011,959 (Annex 11, Johnson), Figure 3, the entry holes 38 for the first stream of environmental air are those which terminate in the passage 34b and are drawn on the left, and the entry holes 38 for the second air stream are those which terminate in the passage 34a and are drawn on the right. The different entry holes are therefore provided

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for the two air streams, so that Claim 2 is independent.

The same applies with respect to Figure 3, perforations 4 and 11, in British Patent 2,095,532 (Annex 41, Townsend).

c) Re Patent Claim 3

44. According to German Offenlegungsschrift 3,011,959 (Annex 11, Johnson), the second end of the air flow passage 44a lies between the ends of the plug and is at a distance from the tobacco end. The reference arrow of reference numeral 8 in Figure 6 happens to point to the region of the space.

The same also applies with reference to Figure 3, item 7, of British Patent 2,095,532 (Annex 41, Townsend).

e) Re Patent Claim 4

45. According to German Patent 1,657,261 (Annex 23, Osmalov), ventilation air flows through the aperture 28 along the passage 22 directly to the smoker's mouth. This passage 22 is sealed at its end remote from the mouth by the seal 31 (cf. column 5, line 32). The wrapping consists of the porous wrapper sheet 24, which allows air to pass through, and an outer sleeve 26 which is impermeable to air flow, but possesses the perforation apertures 28 (cf. column 4, lines 39 to 51). This is Claim 4 verbatim.

The same also applies with reference to Figure 3, items 4 and 6, of British Patent 2,095,532, (Annex 41, Townsend).

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e) Re Patent Claim 5

46. The ventilation holes 10 from Claim 5 are the perforations 10 from Claim 1, which are intended to permit the second ventilation stream. Figure 3 of German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows passages 34a for the first ventilation stream and passages 34b for the second ventilation stream. As regards function, this corresponds to the passages 44a and 44b from Figure 6, as previously described. In accordance with Figure 3, however, the holes corresponding to the ventilation holes 10 are the holes 38 drawn on the right in Figure 3, which are arranged in the right-hand half of the filter plug, separate from the passages 34b, which extend only over the left-hand half. This is Patent Claim 5 verbatim.

f) Re Patent Claim 6

47. Figure 5 in German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows a peripheral passage 26 for the second ventilation stream, which has the same function and same features as indicated in Claim 6. The function of the passages 24 in Patent Claim 6 corresponds to the function previously described for the passages 44b.

g) Re Patent Claim 7

48. Micro-perforated regions are no different from porosities, and a porous wrapping is disclosed by the wrapper sheet 24 in German Patent 1,657,261 (Annex 23, Osmalov) for the application in question here (cf. column 4, lines 39 to 41 of that patent).

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h) Re Patent Claim 8.

49. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows in Figure 1 the filter unit 2, which consists of a filter part 10 and of a cover sheet 12 which is not permeable to air. This cover sheet 12 lines the passages, as Figure 1 shows. To this extent the cover sheet 12 corresponds to the wrapping 7 in Claim 8. Corresponding cover sheets are also provided according to the other exemplary embodiments with reference numerals 22, 32 and 42.

i) Re Patent Claim 9

50. German Patent 1,657,261 (Annex 23, Osmalov) shows a filter plug consisting of two parts 18 and 16. The part 16 consists of filter material (cf. column 3, lines 43 to 51) and the part 18 is filled with charcoal (cf. column 9, lines 21 to 24 and column 10, lines 7 to 11). Charcoal is no different from a filter material. The ventilation passages 22 extend only over the one part 18, but not over the part 16. They are moreover blocked off from the part 16 by the barrier 31 (cf. column 5, line 32).

k) Re Patent Claim 10

51. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson), Figure 2, shows helical passages for the first ventilation stream, and Figure 5 shows helical passages for the second ventilation stream.

- l) Re the restricted Patent Claim 1 in the version of 4th June 1984 from the German Parallel Application 3,303,299.

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52. The same arguments apply as were put forward here with reference to Patent Claims 1 and 6, with reference to the cited German Offenlegungsschrift 3,011,959 (Annex 11, Johnson).

German Auslegeschrift 1,960,364, German Offenlegungsschrift 828,208 and German Offenlegungsschrift 2,209,763 (Annexes 44, Tomkin; 45, Martin and 46, Summers) are cited in the rejection decision of 28th June 1984 (Annex 38) against German Patent Application P 2,303,299, in addition to the printed publications already listed here. They are again cited here with reference to the arguments put forward in the rejection decision.

53. Supplementary reference is also made to the further state of the art:

US Patent 3,596,663 (Annex 42, Scultz) shows in Figure 4, according to the arrows drawn in, a ventilation stream passing through the filter. In addition, according to Figure 1, a first ventilation stream is formed which flows along the passages. Figure 2 shows a filter consisting of two parts.

French Patent 1,349,992 (Annex 43, O'Brien): various exemplary embodiments show peripheral passages, for example Fig. 9, Fig. 10, Fig. 11. Helical peripheral passages are visible in Figure 23, Figure 14 shows an annular passage and Figure 16 shows a multi-part filter.

54. Furthermore, those printed publications which were cited in connection with the other two disputed patents also exhibit features relating to the claims of this disputed patent, in which connection references here are made to the remarks

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made in this context concerning the other two disputed patents, in order to avoid repetition.

III. On the Lamb Patent + 658,775

11. On the question of disclosure of the Lamb Patent

55. One of the objects which the Applicant is attempting to achieve with the invention is a so-called separate circumferential or peripheral ventilation (cf. page 2, right-hand column, lines 6 and 7). This, as already stated in respect of the disclosure of the second disputed patent (Luke, cf. heading 38 above) is a ventilation stream whose air flows direct to the mouthend and is not mixed with the smoke in the filter in order to dilute the smoke therein. This design also conforms to the considerations set out by the Patentee in the penultimate paragraph of the description.

This object can only be achieved, however, if the grooves terminate at the mouth end of the filter rod and not as in, for example, German Offenlegungsschrift 3,011,959 (Annex 11, Johnson), Figure 6, where the groove 44b terminates at the tobacco end. Ventilation air which flows via a groove terminating at the tobacco end passes into the interior of the filter and mixes there with the smoke, and no ventilation air passes directly to the mouth end of the filter in the sense of this stated object.

Naturally, the air thus introduced for the purposes of dilution also passes to the smoker's mouth, but when a distinction is expressly made in the patent between two ventilation streams, and this distinction is further stressed as of particular

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importance (cf. page 3, right-hand column, lines 53 to 61), then this observation is justified, because two ventilation streams differing in the manner described in the quoted paragraph then no longer exist. They can only exist if the grooves for the circumferential and peripheral ventilation terminate at the mouth end. This is not characterized in Patent Claim 1; on the contrary, it is expressly left open at which end of the filter rod the grooves terminate. The patent claim must however indicate all the means necessary to achieve the stated object; it is not sufficient if such aims are first indicated in Claim 5. Claim 5 must therefore be combined with Claim 1 in order to remedy this defect, and this means, since Claim 5 is related to Claim 1 via Claim 3, that Claims 1, 3 and 5 must be combined in a limiting manner to give a new Claim 1 in order to remedy this defect.

This in turn, however, has the effect that the remaining sub claims 2, 4, 6, 7, 8, 9, and 10 can no longer have any validity, since they are not related to Claim 3 and therefore cannot be related to the restricted Claim 1.

56. In the discussion of the state of the art which follows, therefore, it is sufficient to take into account a restricted claim derived in this manner from Claims 1, 3 and 5. If the individual claims are nevertheless treated in the version granted, this is done merely for the sake of clarity and completeness.

12. On German Patent Application P 3,304,763, which is based on the same priority

57. The German Patent Application is based on the same

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priority as the disputed patent and was filed with identical documents.

(further remarks follow)

13. On the Swiss Patent 657,755 (Luke), which is destructive of novelty

58. Swiss Patent 657,755 (Luke) which is the second disputed patent, is based on an earlier priority than the third Swiss disputed patent 658,775 (Lamb), having the priority date of 2nd February 1982 as compared with 16th February 1982.

From the standpoint of the prohibition of double patenting, the second disputed patent (Luke) has priority, irrespective of the dates of application or granting, since the essential content of both patents is based on the priorities. The enclosed priority documents GB 8,202,943 and US 349,103 are submitted as evidence.

Evidence submitted:

- Annex 47 Priority document GB 8,202,943 of 2nd February 1982 (Luke)
Annex 48 Priority document US 349,103 of 16th February 1982 (Lamb)

Since the essential claims of the Lamb patent, of later priority, are already claimed in the Luke patent, of earlier priority, the Lamb patent has no validity because of the prohibition of double patenting (Art. 7a, Patents Act).

59. In order to avoid repetition, since the two patents compared here are discussed in detail with reference to the state of the art, only the

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mutually corresponding claims will be contrasted in the list which follows in order to support the assertion of identity.

Re CH 658,775 (Lamb)	CH 657,755 (Luke)
Later priority	Earlier priority
Patent Claim 1	Patent Claim 1 in combination with page 2, right-hand column, lines 3 and 4; page 3, left-hand column, lines 12 to 14 and lines 5 to 58, and page 3, right-hand column, lines 13 and 14.
Patent Claim 2	Patent Claim 8, first part
Patent Claim 3	Patent Claim 1, precharacterizing clause
Patent Claim 4	Patent Claim 1
Patent Claim 5	Patent Claim 1, precharacterizing clause
Patent Claim 6	Patent Claim 1, characterizing part
Patent Claim 7	Patent Claim 1 and 8
Patent Claim 8	Patent Claim 1 and 8
Patent Claim 9	Patent Claim 1 in combination with page 2, right-hand column, lines 3 and 4; page 3, left-hand column, lines 12 to 14 and lines 5 to 58, and page 3, right-hand column, lines 13 and 14.
Patent Claim 10	Patent Claim 1 in combination with page 3, left-hand column, lines 56 to 68.

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The third disputed patent, of later priority, is thus void on the grounds of double patenting alone.

Since the content of the claims of the patent of later priority is already disclosed in the priority documents of the patent of earlier priority, the priority for the patent of later priority has been wrongly claimed, since it is not based on the first, i.e. oldest application - which would be GB 8,202,943 - as required by the convention agreement, but on a later application justifying priority, namely US 349,103 (cf. Art. 4 C, Paris Convention on the Protection of Industrial Property).

14. On the level of inventiveness as compared with the state of the art

60. The following are cited as state of the art:

- 1) German Offenlegungsschrift 3,011,959 (Johnson)
- 2) British Patent 2,095,532 (Townsend)
- 3) German Auslegeschrift 2,107,850 (Byrne)
- 4) German Offenlegungsschrift 2,849,904 (Filosa)

Evidence Submitted:

Annex 11 German Offenlegungsschrift 3,011,959
(Johnson)

Annex 41 British Patent 2,095,532 (Townsend)

Annex 27 German Auslegeschrift 2,107,850 (Byrne)

Annex 17 German Offenlegungsschrift 2,849,904
(Filosa)

a) Re Patent Claim 1

61. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) is cited with the same arguments as were

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advanced in connection with the level of inventiveness regarding the second disputed patent. In addition to this, it may further be stated that the design of the walls of the grooves 20 is impermeable to air, according to the fourth paragraph of the Patent Claim, which in the case of this citation is evident from the fact that the cover sheet 12 from Figure 4 and 42 from Figure 6 is not permeable to air (cf. Claim 1 of the citation, line 4). This cover sheet lines the grooves, as the drawing shows, and forms the "incorporated wall", which is characterized as impermeable to air in accordance with the Patent Claim (cf. Claim 1, line 16).

British Patent 2,095,532 (Annex 41, Townsend) is cited with the same arguments as were advanced with regard to the level of inventiveness in connection with the second disputed patent. In addition to this, it may further be stated that in this citation the walls of the grooves are formed by the wrapper 6, and this is impermeable to air (cf. page 2, lines 80 and 81). According to Figure 3, the passages formed by the folds are not sealed off from the filter rod 1. Dilution air is thus able to flow from these passages into the interior of the filter rod and contribute to the dilution.

However, the ventilation air aspirated through the apertures 4 finds an easier flow path to the mouth through the passages than through the filter material, which is associated with a strong resistance to flow. Therefore a very great part, at least, of the ventilation air aspirated through the apertures 4 will flow along the passages direct to the mouth end. If the reader of this prior publication wishes to prevent parts of the

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ventilation stream aspirated through the apertures 4 from flowing through the filter material, then he must provide the filter rod with an airtight external covering. He will find a suggestion to this effect in the last paragraph of the description of this prior publication, since it is there stated that, according to Figures 1 and 2, the inner wrapper 2 is omitted (cf. page 2, lines 77 and 78). This inner wrapper 2 is impermeable to air (cf. page 2, lines 34 and 35). Thus the average person skilled in the art, on reading this prior publication, is offered the means for solving the problem of sealing off the passages internally in accordance with the fourth paragraph of the patent claim. In order to do this, the average person skilled in the art must simply not omit the wrapper 2 which is omitted in accordance with Figures 3 and 4.

German Auslegeschrift 2,107,850 (Annex 27, Byrne) is cited with the same arguments as those advanced regarding the level of inventiveness in connection with the second disputed patent. In addition, it may be noted that in this citation a description is given (cf. column 6, lines 40 to 53) of how the filter rod, for example, that shown in Figure 5, can be produced, namely from cellulose acetate, into which the ribs are pressed by hot moulding. As a result of this pressing-in, the cellulose acetate is compressed at its surface and the pores of the cellulose acetate close, at least in part, without it being possible to avoid this.

Evidence that this is the case is provided by the remarks in the third disputed patent. In that patent a filter rod of cellulose acetate is proposed (cf. page 3, left-hand column, lines 64 and

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65). At a later point (cf. page 3, right-hand column, lines 21 et seq.) it is then explained how the surface pores of the cellulose acetate can be sealed by heat.

The citation German Auslegeschrift 2,107,850 (Annex 27, Byrne) thus discloses, by the remarks quoted from column 6, that the design of the inner walls which is more or less impermeable to air. Hence the reader of the citation has available the means he needs to solve the problem of allowing a desired proportion of the ventilation air to flow through the filter and the rest through the passages, thus achieving the two separate ventilation streams.

German Offenlegungsschrift 2,849,904 (Annex 17, Filosa) is cited with the same arguments as those advanced regarding the level of inventiveness mentioned with the second disputed patent. In addition to this it may also be pointed out, with respect to the fourth paragraph of the Patent Claim, that the plug 13, which according to Figure 7 forms the walls of the grooves, consists of material which is impermeable to smoke (cf. page 16, second paragraph).

b) Re Patent Claim 2

62. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows, inter alia, in Figures 3 and 6 a plurality of grooves 34a and 44a arranged in a spatially separate manner on the periphery of the filter rod.

c) Re Patent Claim 3

63. German Offenlegungsschrift 3,011,959 (Annex 11,

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Johnson) shows in Figure 6 that the perforations 58 are arranged approximately in the middle of the tip material 46. Since the tip material projects slightly beyond the filter rod and since the groove 44a does not extend to the tobacco end of the filter rod, the perforations 48 are not opposite the middle of the groove 44a but more at the tobacco end and in fact in the vicinity of this end.

German Offenlegungsschrift 2,849,904 (Annex 17, Filosa) shows in Figure 7 an aperture 24, which lies in the vicinity of the end of the groove which is remote from the mouth.

d) Re Patent Claim 4

64. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows in Figure 3 two rows of perforations 38. The row of perforations shown on the right in Figure 3 lies beyond the end of the grooves 34b which is remote from the opening and emits the ventilating flow of air into the filter rod only via the detour of the grooves 34a.

e) Re Patent Claim 5

65. In all citations quoted with reference to Patent Claim 1, grooves are provided which are open at the mouth end of the filter rod.

f) Re Patent Claim 6

66. In German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) the tip material 16, 27, 36, 46 is perforated in order to allow the ventilation air to flow in at the perforations (cf. e.g. page 11, first paragraph).

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g) Re Patent Claim 7

67. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows in Figure 3 two rows of perforations 38 which, in the finished cigarette, extend in a circular manner around the periphery of the filter rod and are assigned to the two different ventilation streams.

h) Re Patent Claim 8

68. German Offenlegungsschrift 3,011,959 (Annex 11, Johnson) shows two rows of perforations 38 for the two ventilation streams in Figure 3, these rows of perforations being shown and described in a manner identical to one another, so that it is quite obvious that they are designed in the sense of Claim 8. It may further be noted that this claim amounts to nothing more than an inadmissible and unclear rule governing dimensions, and also that it is not supported by the description.

i) Re Patent Claims 9 and 10

69. German Auslegeschrift 2,107,850 (Annex 27, Byrne) describes in column 6, lines 39 et. seq., the sealing of grooves in filter material achieved by the action of heat. It is explained above in connection with the criticism of Patent Claim 1. Reference is here made to this explanation.
70. In connection with Claims 1, 3 and 5, the printed publications German Offenlegungsschrift 3,011,959, British Patent 2,095,532, German Auslegeschrift 2,107,850 and German Offenlegungsschrift 2,849,904 (Annexes 11, Johnson; 41, Townsend and 17, Filosa) are cited as destructive of novelty in the

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abovementioned considerations. These printed publications are also prejudicial in a manner destructive of novelty, with the same arguments, to a restricted patent claim resulting from a combination of Claims 1, 3 and 5 (cf. the remarks relating to the question of disclosure).

71. The other two disputed patents, particularly the second disputed patent, Swiss Patent 6,577,755 (Luke), relate to a similar subject to that of this third disputed patent, so that printed publications quoted in connection with the other two disputed patents likewise relate to the state of the art for this disputed patent, in which connection references here are made to the relevant remarks concerning the other disputed patents, in order to avoid repetition.

15. Legal arguments

72. A precondition for the validity of the patent is, in particular, the novelty of the patent and adequate level of inventiveness of the technical teaching claimed, the revised Patents Act of 17th December 1976 being fully applicable to all three patents in dispute, which were not applied for until the 1980's.
73. The application date of 3rd April 1980, and possibly the priority date of the 11th April 1979, are decisive for the valuation of the novelty and inventiveness of the Johnson patent.

On the one hand, the Plaintiff asserts that the older Filosa Patent +633,421 and the older Osmalov Patent +470,145, though not prior publications, destroy the novelty of the patent in dispute, since all the essential features thereof are anticipated in an identical manner (Article 7a, Patents Act).

Moreover, the teaching of the first patent in

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dispute is derived in an obvious manner from the state of the art, the invention on which the Johnson patent is based representing no advance, or at least no important advance, over what can already be inferred from the individual prior publications cited (Article 1, Section 2, Article 7, Patents Act).

In summary it may be said that all the technical teaching disclosed and claimed in the first disputed patent has been anticipated in its entirety. Swiss Patent 645,252 (Johnson) is therefore entirely invalid due to lack of patentability (Article 1, in conjunction with Article 26, Clause 1, Patents Act).

74. The teaching of the second patent in dispute (Luke) is also derived in an obvious manner from the state of the art, the invention on which the Luke Patent is based representing no advance, or at least no important advance, over what can already be inferred by the average person skilled in the art from the individual prior publications cited (Article 1, Section 2, Article 7, Patent Act). Typically, the German parallel application to the Luke Patent has also been rejected by the Patent Office, and the Defendant has not even attempted to seek a legal remedy and obtain a result more favourable to itself. Swiss Patent 657,755 (Luke) is also therefore entirely invalid due to lack of patentability (Article 1, in conjunction with Article 26, Clause 1, Patents Act).

75. The third patent in dispute (Lamb) is an abridgement of the second disputed patent (Luke), which therefore anticipates the essential features claimed, in a manner which is destructive of novelty (Article 7a, Patents Act). In addition, the third patent in dispute does not even refer to the earliest priority document which discloses the invention, but to a more recent document.

Moreover, the teaching of the third patent in dispute, which in fact represents an abridgement of the second patent in dispute, is derived from the state of the art

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in the same obvious manner as in the case of the second patent in dispute.

The third patent in dispute (Lamb) therefore lacks the necessary level of inventiveness in exactly the same manner as the second patent in dispute (Luke). The third patent in dispute, Swiss Patent 658,775, is also therefore entirely invalid (Article 1, in conjunction with Article 26, Clause 1, Patents Act).

76. The Plaintiff, being a competitor of the Defendant, has a substantial interest in seeing all three disputed patents declared invalid.
77. Since the Defendant has energetically defended himself in Germany against the revocation of his Johnson patent (cf. above, pages 17 et seq.), it cannot be assumed that the said Defendant will voluntarily agree to the cancellation of its parallel Swiss patent. Nevertheless, on 14th May 1985 the Plaintiff invited the Defendant's representative voluntarily to cancel the Swiss Patent 645,252 in question. The Defendant did not see fit to reply to this letter, or even to acknowledge receipt thereof. The present action for revocation therefore became inevitable. The Plaintiff waited for the result of the appeal proceedings in Germany, and then instituted the present action, which is also concerned with the further developments connected with Swiss Patents 657,755 and 658,775.

Evidence submitted:

Annex 49 photocopy of letter from Dr. David to Dr. Troesch AG
dated 14th May 1985

Annex 50 certificate of receipt dated 15th May 1985

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Your obedient servant

Dr. Lucas David

Recorded delivery in quadruplicate

Enclosures according to separate list

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LIST OF ANNEXES

- Annex 1 Plaintiff's power of attorney, undated
- Annex 2 Extract from Swiss Register of Patents +645,252
dated 9th May 1986 (Johnson)
- Annex 3 Extract from Swiss Register of Patents +657,755,
dated 26th May 1987 (Luke)
- Annex 4 Extract from Swiss Register of Patents +658,775,
dated 26th May 1987 (Lamb)
- Annex 5 Swiss Patent Specification +645,252 (Johnson)
- Annex 6 Swiss Patent Specification +657,755 (Luke)
- Annex 7 Swiss Patent Specification +658,775 (Lamb)
- Annex 8 Photocopy of Priority Document, US 029,230 of
11th April 1979
- Annex 9 Photocopy of US Patent Specification 4,256,122
(Johnson)
- Annex 10 Photocopy of unalterable copy of the patent
claims and description
- Annex 11 Photocopy of description from the Patent DE
30 11 959 dated 27th October 1982 (Johnson)
- Annex 12 Photocopy of the submission by Dr. H. Kinkeldey
Patent Agent of 15th January 1982 for Brown and
Williamson to 10 W (pat) 88/81 (P 30 11 959.6.-23)
- Annex 13 Official decision of German Patent Office dated
31st July 1981 with reference to P 30 11 959.
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- Annex 14 Decision of the Federal Patent Court on appeal
by Applicant, dated 27th October 1982 with
reference to Patent 3,011,959, 6-23
- Annex 15 Official decision of the German Patent Office
dated 5th November 1984 with reference to Patent
3,011,959
- Annex 16 Judgement of the German Federal Patent Court of
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- Annex 18 Swiss Patent 633,421 dated 15th December 1982
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- Annex 19 German Patent Application P 2,858,154
- Annex 20 Official Decision rejecting German Patent
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- Annex 21 Declaration of Partial Abandonment of Swiss
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- Annex 22 US Patent Specification 3,490,461 of 20th
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- Annex 35 Photocopy of decision by German Patent Office
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- Annex 36 Photocopy of submission of Kinkeldey, Patent
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- Annex 37 Photocopy of new patent claims of 4th June 1984
- Annex 38 Photocopy of official decision to rejection by
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- Annex 47 Priority document GB 8,202,943 of 2nd February
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- Annex 49 Photocopy of letter from Dr. David/Dr. Troesch,
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